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EXAMINER

SHORTSLE, KEVIN P

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 05/31/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/506,795

Applicant(s)

BETHUNE ET AL.

Examiner

Kevin P. Shortsle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) 7, 11, 13, 15, 17-19, 36-72, 74 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 12, 14, 16, 20-35 and 73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 8-10, 12, 14, 21 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Schafer (DE 2212995). Schafer discloses a method of applying pieces of material to objects comprising: providing a material supply strip initially including a backing having first and second opposing surfaces and pieces of material removably arranged on both of the first and second surfaces and at least one applicator device, applying at least one piece of material from the first surface of the backing to at least one object with said at least one applicator device, and applying at least one piece of material from the second surface of the backing to at least one object with said at least one applicator device (See Figs. 3-4, Page 18, lines 10-12, Page 20, 2<sup>nd</sup> paragraph).

Regarding claim 2, the at least one applicator device includes at least one application station configured to apply pieces of material to objects, and wherein the applying of said at least one piece of material from the first surface and applying from the second surface includes passing the supply strip through the at least one application station.

Regarding claim 3, the at least one application station includes first and second application stations, and wherein the applying from the first surface includes passing the

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supply strip through the first application station, and the applying from the second surface includes passing the supply strip through the second application station.

Regarding claim 4, the supply strip is passed through the second application station after the supply strip is passed through the first application station.

Regarding claim 5, the at least one applicator device includes first and second sections, wherein the first surface being oriented to face the first section and the second surface being oriented to face the second section when the supply strip is passed through the first application station, the method further comprises re-orienting the supply strip so that the second surface faces the first section and the first surface faces the second section when the supply strip is being passed through the second application station (See Fig. 4).

Regarding claim 8, the method further comprises winding the supply strip into a roll on a spool after at least one of the applying from the first surface and applying from the second surface.

Regarding claim 9, the supply strip is initially in the form of a roll on a spool, wherein the method further comprises feeding the supply strip from the spool.

Regarding claim 10, the method further comprises winding the supply strip into a roll on a second spool after at least one of the applying from the first surface and applying from the second surface.

Regarding claim 12, the supply strip is initially in the form of a roll on a first spool, the method further comprises: feeding the roll of supply strip from the first spool to the

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first application station, and winding the supply strip into a roll on a second spool after the supply strip is passed through the second application station.

Regarding claim 14, wherein at least one piece of material from the first surface and at least one piece of material from the second surface are applied to a group of common objects.

Regarding claim 21, the pieces of material are labels.

Regarding claim 73, the first applicator device is used for applying at least one piece of material from the first surface and the second applicator device is used for applying at least one piece of material from the second surface.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer as applied to claim 5 above, and further in view of Moncrieff Baldwin et al. (USPN 5,143,466 and henceforth referred to as Baldwin). Schafer discloses re-orienting the supply strip between application stations. Schafer is silent to twisting. One in the art would appreciate twisting the supply strip to reposition the second surface. It is known and conventional to twist a strip approximately 180 degrees to reposition the second surface of said strip as shown, for example, by Baldwin (See Fig. 1, items 34, 61, 62, 51

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and Col. 4, lines 27-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to twist the supply strip of Schafer to reposition the second surface as shown by Baldwin in order to simplify the conveying system of Schafer to resemble that of a straight line, therefore eliminating the need for guide rollers that alter the direction of the conveyance path of the supply strip.

5. Claims 16, 20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer as applied to claims 1 and 14 above, and further in view of Wochner (USPN 3,861,986). Schafer may be silent to the types of material on the supply strip. One in the art would appreciate pieces of material that are different may be supplied. It is well known and conventional to provide a supply strip having different pieces of material as shown, for example, by Wochner (See Col. 1, lines 55-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide pieces of material on the first surface different from pieces of material on the second surface as applying different pieces of material to objects is well known and conventional as shown by Wochner.

Regarding claim 34, bottles as the objects are disclosed (See Wochner, Col. 1, lines 5-10).

6. Claims 22, 24-26, 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer as applied to claims 1 and 21 above, and further in view of Brandt et al. (USPN 6,379,761). Schafer may be silent to the particular properties of the

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supply strip, backing and labels. One in the art would appreciate such properties are well known and conventional for supply strips that provide labels to objects. It is well known and conventional to provide a supply strip with such properties as shown, for example, by Brandt et al. (See Col. 3, lines 2-4, 44-46, Col. 5, lines 10-16, Col. 6, lines 61-63, Col. 8, lines 36-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such a supply strip, backing and labels with properties as those disclosed by Brandt et al. as they are well known and conventional properties of such and also to provide labels that can be easily and economically removed and re-applied (See Col. 2, lines 9-14).

Further regarding claim 33, the adhesive that removably adheres the pieces of material in Brandt et al. is considered to fall within the range of thickness as claimed. One in the art would appreciate the thickness of the adhesive of Brandt et al. as depicted is thinner than the backing (See Fig. 1, items 1 and 2).

7. Claims 23 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer as applied to claim 21 and above, and further in view of Amano et al. (USPN 5,376,417). Schafer may be silent to the particular material of the labels. One in the art would appreciate choosing any conventional label as is known in the art. Amano et al. disclose conventional labels made of PET (polyethylene terephthalate) (See Col. 1, lines 30-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to choose PET as the material for the label as is well known and conventionally used for labels that are applied to objects.

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Further regarding claim 35, PET is known to be transparent. One of ordinary skill in the art would appreciate conventional labels may be transparent and that PET labels may be transparent.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer as applied to claim 21 above, and further in view of Amano et al., Brandt et al. and Hirose et al. (USPN 5,569,540). Schafer may be silent to the types of material used for the labels and backing. Amano et al. disclose conventional labels are made from PET, but are silent to a particular backing (See Col. 1, lines 30-31, Col. 5, lines 25-26). Brandt et al. disclose conventional backings may be formed from many different polymer substrates, and cite examples such as polypropylene and polyester (See Col. 10, lines 4-8). Brandt et al. is silent to PET. One in the art would appreciate PET is included in the discussion by Brandt et al. and is a conventional polymer substrate used as a backing. Hirose et al. disclose polyesters and polypropylene may be used as backings, and provides a specific example to PET (See Col. 3, lines 55-65 and Col. 6, lines 40-42). One in the art would appreciate such materials are well known and conventional alternatives. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a PET label on a PET backing as are well known and conventional materials used for supply strips as shown by Amano et al and Brandt et al., and supported by Hirose et al.



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9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer as applied to claim 1 above, and further in view of Brandt et al. and Hirose. Schafer may be silent to the particular material used for the backing. Brandt et al. disclose conventional backings may be formed from many different polymer substrates, and cite examples such as polypropylene and polyester (See Col. 10, lines 4-8). Brandt et al. is silent to PET. One in the art would appreciate PET is included in the discussion by Brandt et al. and is a conventional polymer substrate used as a backing. Hirose et al. disclose polyesters and polypropylene may be used as backings, and provides a specific example to PET (See Col. 3, lines 55-65 and Col. 6, lines 40-42). One in the art would appreciate such materials are well known and conventional alternatives. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a PET backing as is a well known and conventional material used for supply strips as shown by Brandt et al. and supported by Hirose et al.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin P. Shortsle whose telephone number is 703-308-8193. The examiner can normally be reached on M-F, 8-4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



K. P. Shortsle  
May 28, 2002



RICHARD CRISPINO  
SUPERVISORY PATENT EXAMINER  
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